



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,636	06/27/2000	Marco A. DeMello	MSFT-0189/154576.1	3999

7590

11/20/2003

Peter M Ullman
Woodcock Washburn Kurtz Mackiewicz
& Norris LLP
One Liberty Place 46th Floor
Philadelphia, PA 19103

EXAMINER

ZHEN, LI B

ART UNIT	PAPER NUMBER
----------	--------------

2126

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

KS

Office Action Summary

Application No.

09/604,636

Applicant(s)

DEMELLO ET AL.

Examiner

Li B. Zhen

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 5 – 10, 15, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,021,492 to May.

As to claim 1, May teaches detecting the installation of predetermined software [initiates request to verify software versions on the remote computer; col. 7, line 43 – col. 8, line 30];

detecting an activation status [activation status is places as inactive] of the predetermined software [user is queried as to whether additional use is requested; col. 11, lines 54 – 67]; and

if the activation status indicates that the predetermined software is not activated [a request activation, re-activation or change of parameters in software is made; col. 9, line 57 – col. 10, line 23], launching an activation feature to activate the predetermined software [an agreement on terms is reached, in a step 163, a user of the computer system is notified...by an activation message or an activation page being sent to the

computing system...in a step 165 a coupon is activated in accordance with the terms agreed upon in step 162, Fig. 10; col. 10, lines 1 - 23].

As to claim 10, this is a method claim that corresponds to product claim 1; note the rejection to claim 1 above, which also meets this method claim. As to the additional limitations, May teaches a remote computer device [remote computer; col. 7, lines 43 – 60].

As to claim 5, May teaches launching the predetermined software [once the software is activated within the computing system, use of the software is metered according to the agreed upon style and parameters; col. 2, lines 5 – 43].

As to claims 6 and 7, May teaches the predetermined software enables the viewing of a first plurality of titles regardless of the activation status of the predetermined software [if it is detected that the user has not completed an access level the user is allowed continued access to the software; col. 11, lines 33 – 55], and the predetermined software enables the viewing of a second plurality of titles only if the predetermined software is activated [if it is detected that the user has completed an access level, a check is made to determine whether the user is authorized to use the next level...if it is determined that the user is authorized to use the next level, the user is allowed continued access to the software; col. 11, lines 33 – 55].

As to claims 8 and 19, May teaches providing an activation certificate [a coupon is activated in accordance with the terms agreed upon; col. 10, lines 1 – 25].

As to claims 9 and 18, May teaches providing data which identifies a user who activates the predetermined software [MIS system updates its data base information on the customer; col. 8, lines 12 – 29].

As to claim 15, see the rejection to claim 1 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 – 4, 11 – 14, 16, 17, and 20 – 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over May in view of U.S. Patent No. 6,298,446 to Schreiber.

As to claims 2, 11, 31 and 39, May teaches communications over the internet and the world wide web [col. 3, lines 38 – 52] but does not specify a client scripting language.

However, Schreiber teaches protection of digital images transmitted over a network [col. 6, lines 18 – 26] and a client scripting language [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15].

It would have been obvious to a person of ordinary skill in the art at the time of the invention to apply the teaching of client scripting language as taught by Schreiber to the invention of May because scripting languages provide quick and easy development, cycle-compiling and linking is not necessary.

As to claim 23, May as modified teaches an electronic distribution infrastructure [copyright protection of digital images for use within a distributed server-client computing environment; col. 9, lines 8 – 33 of Schreiber], the method comprising:

providing, to a first party [client computers 106; col. 9, lines 9 – 33 of Schreiber], at least one of the following: a first set of computer-executable instructions for use with first browsing software [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber]; and a second set of computer-executable instructions for use with second browsing software [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber], and

providing, to a second party [server computer 100; col. 9, lines 9 – 33 of Schreiber], a browser-executable script which uses either the first or the second sets of instructions [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15 of Schreiber], according to whether the script is executed under the first or the second browsing software [software such as a Netscape plug-in or an Internet Explorer Active-X control is used to modify operating system function; col. 19, lines 1 - 10 of Schreiber]. As to detecting installation of the software; detecting activation of the software; activate the software; providing information related to the identity of the first party; and providing an activation certificate associated with the first party, see the rejection to claims 1, 8 and 9 above.

As to claim 36, May as modified teaches including a script of instructions in a web page and transmitting the web page to the remote computing device [in response

Art Unit: 2126

to a user selecting a URL with a CGI script or such other script, client computer 106 issues an HTTP request to server computer 100 that includes instructions for generating a web page; col. 16, lines 1 – 15 of Schreiber]. As to detecting the installation of software; detecting the activation of the software; activate the software; providing information related to the identity of a user; and providing an activation certificate associated with the user, see the rejection to claims 1, 8 and 9 above.

As to claims 3, 13, 32 and 40, May as modified teaches the client scripting language is selected from the group consisting of: Java [Java Applets; col. 6, lines 25 – 43 of Schreiber] and VISUAL BASIC [CGI script instructions or Visual Basic instructions, col. 14, lines 55 – 62; col. 16, lines 1 – 15 of Schreiber].

As to claim 4, May as modified teaches the one or more scripting functions enable use of the computer-executable instructions with at least two different browsing programs [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet... for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber].

As to claim 12, May as modified teaches the script functions are interpretable by a web browser using a scripting language [opens a URL for an active server page in his web browser; col. 16, line 63 - col. 17, line 17 of Schreiber].

As to claims 14 and 34, May as modified teaches the first and second instructions are transmitted in an HTTP web page [in response to a user selecting a URL with a CGI script or such other script, client computer 106 issues an HTTP request

to server computer 100 that includes instructions for generating a web page; col. 16, lines 1 – 15 of Schreiber].

As to claim 16, May as modified teaches the first and second instructions are implemented by way of a COM object [Active-X control] on the first computing device [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber].

As to claim 17, May as modified teaches the first and second instructions are implemented as a browser plug-in on the first computing device [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber].

As to claim 20, May as modified teaches the software comprises a digital content rendering application [additional software is used to decode the encrypted image data, and render it for display on a video monitor; col. 7, lines 1 – 19 of Schreiber].

As to claims 21 and 26, May as modified teaches [col. 9, lines 9 – 33 of Schreiber] the first party is a consumer of digital content [serves web pages 104 to a plurality of client computers 106 over the Internet], and the second party is a distributor of digital [web pages 104 typically contain references to images] content [server computer 100 typically includes web server software 102 that serves web pages 104, Fig. 1].

As to claims 22, 35 and 42, May as modified teaches a computer-readable medium [a hard disk 42, Fig. 3; col. 4, lines 35 – 45 of May].

As to claims 24 and 25, see the rejection to claim 23.

As to claim 27, May as modified teaches the second party distributes information supplied by a third party [copyright protection of digital images for use within a distributed server-client computing environment; col. 9, lines 8 – 33 of Schreiber].

As to claim 28, May as modified teaches the information comprises an electronic book [copyright protection of other forms of multi-media referenced in web pages as well, such as audio files, video files and slide shows; col. 32, line 60 – col. 33, line 5 of Schreiber].

As to claims 29 and 30, May as modified teaches the multimedia files comprise one or more of the following: music, video, animations, and pictures [copyright protection of other forms of multi-media referenced in web pages as well, such as audio files, video files and slide shows; col. 32, line 60 – col. 33, line 5 of Schreiber].

As to claim 33, May as modified teaches a COM object for use with a MICROSOFT INTERNET EXPLORER browser [for the Internet Explorer web browser, such additional software may be an Active-X control or a Java applet; col. 7, lines 1 – 19 of Schreiber], and wherein the second set of computer-executable instructions comprises a plug-in for use with a NETSCAPE NAVIGATOR browser [for the Netscape Communicator web browser, such additional software may be a plug-in or a Java applet; col. 7, lines 1 – 19 of Schreiber].

As to claims 37 and 38, see the rejection to claim 36.

As to claim 41, May as modified teaches detect whether the script is executing on first browsing software or second browsing software and perform either a first action or a second action according to whether the script is executing on the first or the second

Art Unit: 2126

browsing software [software such as a Netscape plug-in or an Internet Explorer Active-X control is used to modify operating system function; col. 19, lines 1 – 10 and col. 7, lines 1 – 19 of Schreiber].

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,006,332 to Rabne teaches a rights management system for digital media.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Li B. Zhen whose telephone number is (703) 305-3406. The examiner can normally be reached on Mon - Fri, 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Li B. Zhen
Examiner
Unit 2126

lbz
November 13, 2003